

REMARKS

1) Applicants have amended the specification to include the names of the parties to a joint research agreement in effect on or before the date the claimed invention was made, in accordance with MPEP § 706.02(l)(1) and § 706.02(l)(2).

2) The Examiner stated that claims 19-23 and 25-36 are pending in the application. Claims 32-36 are withdrawn and claims 19-23 and 25-31 were examined on their merits.

Rejections under 35 USC 103(a)

3) The Examiner stated that claims 19, 25, 26, 27, and 31 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Hugli (USPN 6,235,494 B1) in view of Braven et al. (US 2005/0221315 A1) for reasons of record set forth in the Prior Actions of March 17, 2009 and September 30, 2008.

4) The Examiner stated that claims 19, 20, 22, 23, 25, 26, and 27 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Ludin et al. (USPN 6,495,336 B1) in view of Braven et al. for reasons of record set forth in the Prior Actions of March 17, 2009 and September 30, 2008.

5) The Examiner stated that claims 19, 20, 22, 25, 26, 28, 29, and 30 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagy (2000) in view of Braven et al. for reasons of record set forth in the Prior Actions of March 17, 2009 and September 30, 2008.

6) The Examiner stated that claims 19-22, 25, 26, 28, 29, and 30 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagy (2000) in view of Braven et al. and further in view of Forrest et al. (USPN 4,978,610) for reasons of record set forth in the Prior

Actions of March 17, 2009 and September 30, 2008.

7) The Examiner stated that claims 19, 20, 22, 23, 25, 26, 28, 29, and 30 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagy (2000) in view of Braven et al. and further in view of Nicholson (USPN 4,456,337) for reasons of record set forth in the Prior Actions of March 17, 2009 and September 30, 2008.

8) The Examiner stated that the Declaration under 37 CFR § 1.132 filed September 17, 2009 was insufficient to overcome the rejection of claims 19-23 and 25-31 based upon 35 USC § 103(a) in view of Braven et al. (US 2005/0221315 A1) as set forth in the last Office action because: The Declaration indicated that the inventive disclosure of US 2005/0221315 A1 was by H. Braven and R. Keay. However, the instant application is a different inventive entity from US 2005/0221315 A1, having three co-inventors: H. Braven, R. Keay, and S. Flower.

The Examiner then stated that the Declaration failed to show that the relevant portions of the US 2005/0221315 A1 reference (two inventors) originated with or were obtained from Applicant (three inventors). That is, the Examiner continued, the Declaration failed to indicate that while S. Flower is a co-inventor of some claims in the instant invention, his co-inventorship does not co-extend to the claimed subject matter disclosed in US 2005/0221315 A1 reference but that he did contribute to the subject matter disclosed in Braven et al. pertinent to the instant rejection. That is, the Examiner continued, the contribution of Stephen Flower to what specific claims of the instant application which were not in the Braven et al. reference are not described.

The Examiner stated that to effectively overcome the rejections of claims 19-23 and 25-31 based upon 35 U.S.C. § 103(a) in view of Braven et al. as set forth in the last Office Actions,

Applicants must submit a Declaration under 37 C.F.R. § 1.132 which specifically indicates which instant claims S. Flower contributed to and which claims S. Flower did not contribute to and thus show that the Braven et al. reference is not by another with regard to those claims to which Stephen Flower did not contribute or effectively explain why Stephen Flower is an inventor of the subject matter found in the USPGPUB (US 2005/0221315 A1) which is co-extensive with the instant claims and thus show that this unclaimed subject matter of the reference was in fact invented by the inventive entity of the instant application.

In an earlier Office action, mailed 30th September 2008, the Examiner had stated that the rejection under under 35 U.S.C. § 103(a) as being unpatentable over Hugli (USPN 6,235,494 B1) in view of Braven et al. (US 2005/0221315 A1) might be overcome “by showing that the reference is disqualified under 35 U.S.C. § 103(c) as prior art in a rejection under 35 U.S.C. § 103(a) and directed Applicants to MPEP § 706.02(l)(1) and § 706.02(l)(2). The Examiner also had noted in a subsequent Office action, mailed 17th March 2009, that Applicants had appeared to attempt to disqualify the reference under 35 U.S.C. § 103(c) as prior art in a rejection under 35 U.S.C. § 103(a) as subject matter being Commonly Owned or subject to a Joint Research Agreement. This, the Examiner had stated, was not persuasive, as no evidence had been provided to support the assertion (Office action, mailed 17th March 2008, at page 6, fourth and fifth paragraphs).

9) With a view to clarifying the Examiner’s rejections and responses, Applicants’ Agent requested a telephonic interview with the Examiner’s supervisor, Jon Weber, on 22nd December, 2009. Examiner Weber graciously granted a telephonic interview with Applicants’ Agent and the Examiner’s rejections and responses in the instant Office action were discussed.

Applicants' Agent, Matthew Kaser, suggested that in view of the Examiner's earlier suggestions regarding that the rejections might be overcome by showing that the reference is disqualified under 35 U.S.C. § 103(c) as prior art in a rejection under 35 U.S.C. § 103(a) and in view that the Declaration under 37 C.F.R. § 1.132 (dated July 24, 2009) made by John Clarkson clearly stated that "Atlas Genetics Ltd. is the assignee of the above-referenced (instant) application for patent ('290 application) and assignee of published patent application, US 2005/0221315 A1 ("Braven et al.")". Examiner Weber responded that such a showing might overcome the rejections under 35 U.S.C. § 103(a).

10) Applicants submit that the instant application for patent ('290 application) and the Braven et al. reference were, at the time the claimed invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s).

Applicants have amended the specification to include the names of the parties to a joint research agreement in effect on or before the date the claimed invention was made, in accordance with MPEP § 706.02(l)(1) and § 706.02(l)(2).

Applicants note that the CEO of Atlas Genetics Limited, John Clarkson, stated in the previously-filed Declaration under 37 C.F.R. § 1.132 (dated July 24, 2009; copy enclosed) that "Atlas Genetics Ltd. is the assignee of the above-referenced (instant) application for patent ('290 application) and assignee of published patent application, US 2005/0221315 A1 ("Braven et al.")".

Applicants submit that MPEP § 706.02(l)(1) and § 706.02(l)(2) state

"Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at

the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person”; “subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. 102 shall not preclude patentability under 35 U.S.C. 103 where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person”; and “(i)n order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned, or subject to an obligation of assignment to a same person, at the time the claimed invention was made or be subject to a joint research agreement at the time the invention was made”. MPEP § 706.02(l)(1) and § 706.02(l)(2).

Applicants submit that the Assignment of co-inventors of the claimed invention to Atlas Genetics Limited was recorded at the USPTO on 23rd October 2006 at Reel/Frame 018445/0066.

Applicants also submit that the Assignment of co-inventors of the subject matter of the Braven et al. reference to Molecular Sensing PLC was recorded at the USPTO on 4th May 2005 at Reel/Frame 015981/0840.

Subsequently, the Assignment of Intellectual Property Rights from Molecular Sensing PLC to Atlas Genetics Limited was recorded on 12th February 2010 at the USPTO at Reel/Frame 023945/0001 (copy attached).

For the additional benefit of the Examiner, Applicants enclose a copy of the Assignment of Patent Rights (the Braven et al. reference) by Molecular Sensing PLC to Atlas Genetics Limited on 16th September 2005. Applicants also enclose a copy of a change of address for Atlas Genetics, Inc. that was recorded at Companies House, London, United Kingdom, on 28th March 2008.

Applicants submit that the Declaration made by Dr. Clarkson on July 24, 2009, shows that the subject matter of the Braven et al. reference and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person and therefore does not preclude the instant claims from patentability under 35 U.S.C. § 103(c).

Applicants believe that, together with the enclosed supporting evidence and the earlier Declaration under 37 C.F.R. § 1.132 by John Clarkson, Applicants' submission that the instant application for patent ('290 application) and the Braven et al. reference were, at the time the claimed invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s) disqualifies the Braven et al. reference under 35 U.S.C. § 103(c) as prior art in a rejection under 35 U.S.C. § 103(a).

Therefore, Applicants believe that the Braven et al. reference is disqualified under 35 U.S.C. § 103(c) as prior art in the rejection under 35 U.S.C. § 103(a) and the rejections under 35 U.S.C. § 103(a) of claims 19, and dependent claims 20, 21, 22, 23, 25, 26, 27, 28, 29, 30, and 31 are overcome.

In determining obviousness, "[i]t is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure." By way of contrast, in determining novelty, a showing that the "prior art reference cited as anticipating a claimed invention. . . lack[ed] the characteristics of the claimed invention. . . would in fact negate the assertion that the claimed invention was described in the prior art." *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

Although published subject matter is "prior art" for all that it discloses, in order to render an invention unpatentable for obviousness, the prior art must enable a person of ordinary skill to make and use the invention. To render

a later invention unpatentable for obviousness, the prior art must enable a person of ordinary skill in the field to make and use the later invention Beckman Instruments, 892 F.2d at 1551. (In re Kumar, Fed. Cir. No. 04-1074).

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." *Graham v. John Deere Co.*, 148 USPQ 459, 467 (S.Ct. 1966).

11) With the disqualification of the Braven et al. reference under 35 U.S.C. § 103(c) as prior art in the rejection under 35 U.S.C. § 103(a), Applicants submit that claim 19, and dependent claims 25, 26, 27, and 31, are therefore not unpatentable over Hugli (USPN 6,235,494 B1) in view of Braven et al. Furthermore, Applicants submit that Hugli does not disclose a method for detecting protease activity wherein the method comprises a step of contacting the sample solution with a protease substrate labeled with an electrochemically active marker, wherein the electrochemically active marker is a metallocene moiety. Therefore, Hugli lacks the characteristics of the claimed invention and is different to the claimed invention.

Applicants respectfully request that the rejection of claims 19, 25, 26, 27, and 31 under 35 U.S.C. § 103(a) be withdrawn.

12) With the disqualification of the Braven et al. reference as prior art, Applicants submit that claim 19, and dependent claims 20, 22, 25, 26, and 27, are therefore not unpatentable over Ludin et al. (USPN 6,495,336 B1) in view of Braven et al. Furthermore, Applicants submit that Ludin et al. do not disclose a method for detecting protease activity wherein the method comprises a step of contacting the sample solution with a protease substrate labeled with an electrochemically active marker, wherein the electrochemically active marker is a metallocene moiety. Therefore, Ludin et al. lack the characteristics of the claimed invention

and is different to the claimed invention.

Applicants respectfully request that the rejection of claims 19, 20, 22, 25, 26, and 27 under 35 U.S.C. § 103(a) be withdrawn.

13) With the disqualification of the Braven et al. reference as prior art, Applicants submit that claim 19, and dependent claims 20, 22, 25, 26, 28, 29, and 30, are therefore not unpatentable over Nagy et al. (2000) in view of Braven et al. Furthermore, Applicants submit that Nagy et al. does not disclose a method for detecting protease activity wherein the method comprises a step of contacting the sample solution with a protease substrate labeled with an electrochemically active marker, wherein the electrochemically active marker is a metallocene moiety. Therefore, Nagy et al. lack the characteristics of the claimed invention and is different to the claimed invention.

Applicants respectfully request that the rejection of claims 19, 20, 22, 25, 26, 28, 29, and 30 under 35 U.S.C. § 103(a) be withdrawn.

14) With the disqualification of the Braven et al. reference as prior art, Applicants submit that claim 19, and dependent claims 20-22, 25, 26, 28, 29, and 30, are therefore not unpatentable over Nagy in view of Braven et al. and further in view of Forrest et al. (USPN 4,978,610). Furthermore, Applicants submit that neither Nagy nor Forrest et al. disclose a method for detecting protease activity wherein the method comprises a step of contacting the sample solution with a protease substrate labeled with an electrochemically active marker, wherein the electrochemically active marker is a metallocene moiety. Therefore, Nagy et al. and Forrest et al. both lack the characteristics of the claimed invention and are different to the claimed invention.

Applicants respectfully request that the rejection of claims 19-22, 25, 26, 28, 29, and 30 under 35 U.S.C. § 103(a) be withdrawn.

15) With the disqualification of the Braven et al. reference as prior art, Applicants submit that claim 19, and dependent claims 20, 22, 23, 25, 26, 28, 29, and 30, are therefore not unpatentable over Nagy et al. in view of Braven et al. and further in view of Nicholson et al. (USPN 4,456,337). Furthermore, Applicants submit that neither Nagy nor Nicholson et al. disclose a method for detecting protease activity wherein the method comprises a step of contacting the sample solution with a protease substrate labeled with an electrochemically active marker, wherein the electrochemically active marker is a metallocene moiety. Therefore, Nagy et al. and Nicholson et al. both lack the characteristics of the claimed invention and are different to the claimed invention.

Applicants respectfully request that the rejection of claims 19, 20, 22, 23, 25, 26, 28, 29, and 30 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION


With these amendments and arguments, Applicants believe that the application is in condition for allowance. If the US Patent Office believes that communication would further the prosecution of this application, then the appropriate US Patent Office personnel are invited to contact the Applicants' below-signed representative at their earliest convenience.

This Response is being filed together with a Request for Continued Examination under 37 CFR § 1.114.

Please charge Deposit Account No. **50-3194** in the amount of **\$490.00** as set forth in the enclosed transmittal letter. Further, if the USPTO determines that an additional fee is due, the Commissioner is hereby authorized to charge Bell & Associates' Deposit Account No. **50-3194**.

Respectfully submitted,

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